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In re Application of	:	DECISION ON
MATSUI	:	
Application No.: 10/561,629	:	PETITION UNDER
PCT No.: PCT/JP2004/008710	:	
Int. Filing Date: 21 June 2004	:	37 CFR § 1.47(b)
Priority Date: 20 June 2003	:	
Attorney Docket No.: 19036/40796	:	
For: OPTHALMIC COMPOSITION	:	

This is a decision on applicant's second renewed petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 20 May 2008.

BACKGROUND

On 21 June 2004, applicant filed international application PCT/JP2004/008710, which designated the US and claimed a priority date of 20 June 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 December 2005.

On 20 December 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 July 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for reply.

On 07 February 2007, applicant submitted a petition under 37 CFR 1.47(b) and a petition under 37 CFR 1.183. The petitions were accompanied by, *inter alia*, a petition/fee for a five month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of facts by Madoka Yamashita, and a memorandum of law by Tadato Fujiwara.

On 16 March 2007, applicant submitted a petition under 37 CFR 1.182.

On 11 June 2007, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b), applicant's petition under 37 CFR 1.183, and applicant's petition under 37 CFR 1.182.

On 09 October 2007, applicant filed a renewed petition under 37 CFR 1.47(b) and the petition under 37 CFR 1.59(b). The petition under 37 CFR 1.47(b) was accompanied by, *inter alia*, a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, a statement of facts by Naoka Harada, a statement of facts by Yasuyo Yamaguchi, a statement of facts by Naonori Murakami, an English translation of the priority document for the instant application—Japanese Application No. 2003-176965, a chart showing support in the English translation of the priority document for the claims in the instant application, a copy of an oath signed by nonsigning inventor Yuka Matsui dated 16 April 2001 and an English translation thereof, and a copy of "Regulations for Employee's Invention" and an English translation thereof.

On 24 March 2008, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b) and granting applicant's petition under 37 CFR 1.59(b). Regarding the petition under 37 CFR 1.47(b), it was noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 20 May 2008, applicant filed the instant second renewed petition under 37 CFR 1.47(b) which was accompanied by a "redline" comparison of the specification portion of the English translation of the priority application and the specification portion of the international application

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As noted in the decision mailed 24 March 2008, , items (1)-(4) and (6) have been met.

Item (5) still has not been met. The decision mailed 24 March 2008 indicated that it was not clear that there was "no matter" in the international application which was not in the priority application. The renewed petition takes issue with this statement. The decision should have

indicated “no new matter” rather than “no matter.” See MPEP 409.03(f) which states in part: “An assignment of an application and any ‘reissue, division, or continuation of said application’ does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm’r Pat. 1956)”. Any inconvenience is regretted.

Applicant has provided a copy of an assignment (in the petition filed 16 March 2007) from non-signing inventor Yuka Matsui to Kobayashi Pharmaceutical for the application–2003-176965 filed 20 June 2003—which the international application claims priority to. Applicant contends that the priority application and the international application are “substantively essentially identical”. A “redline” comparison of the specification portion of the English translation of the priority application and the specification portion of the international application has been provided to support this contention. However, there appear to be three differences between the translations that may be significant: on page 1, “various” was changed to “variable”; on page 2, “elements” was changed to “means”; and on page 6, “tonicity” was changed to “isotonizing”. The change on page 2 appears to be the most significant. Thus, it would be inappropriate on the present record to conclude that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application has been provided.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47(b)”. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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